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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,088	03/12/2004	Shinya Haraguchi		8524
7590	02/01/2005		EXAMINER	
<b>Jay H. Maioli</b> Cooper & Dunham 1185 Avenue of the Americas New York, NY 10036				KIM, AHSHIK
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 02/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application N .	Applicant(s)
	10/799,088	HARAGUCHI, SHINYA
	Examin r	Art Unit
	Ahshik Kim	2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 11/10/04 (Amendment).
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 5-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 5-9 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

## DETAILED ACTION

### *Amendment*

1. Receipt is acknowledged of the amendment filed on November 10, 2004. In the  
5 amendment claims 5-8 were amended. Currently, claims 5-9 remain for examination.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

10        A person shall be entitled to a patent unless –  
15        (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 5, 6, and 9 are rejected under 35 U.S.C. 102(e) as being anticipated Pieterse et al. (US 5,714,741, hereinafter “Pieterse”).

20        Re claims 5, 6, and 9, Pieterse teaches a method and the apparatus for processing data in a potable terminal 13 having an interface 1 for connecting with an integrated circuit (IC) card (11) (see abstract; col. 2, lines 37+; col. 4, lines 3+). The device allows users to consummate financial transaction (col. 1, lines 26+) where the users are required to enter identification information (col. 1, lines 39+). The identification number such as PIN number can be either 25 entered or stored in the interface device or in the IC card (col. 5, line 62 – col. 6, line 8). The card information such as remaining balance is updated (col. 6, line 66 – col. 7, line 13; col. 10, lines 1-13). As shown in figure 6, the interface device and the host (or the secure module)

communicate in asynchronous fashion (meaning that one sends the command, and the other acknowledges and responds to the command).

***Claim Rejections - 35 USC § 103***

5 4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all  
obviousness rejections set forth in this Office action:

10 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in  
section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are  
such that the subject matter as a whole would have been obvious at the time the invention was made to a person  
having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the  
manner in which the invention was made.

15 5. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pieterse et  
al. (US 5,714,741) in view of Zuppich (US 6,213,392, hereinafter “Zuppich”). The teachings  
of Pieterse have been discussed above.

Pieters, however, fails to specifically teach or fairly suggest the result of writing  
operation is checked for error condition, which includes producing a buzzer sound.

20 Zuppich teaches a smart card and smart card interface system (see abstract),  
comprising, among other things, a buzzer (col. 6, lines 33+). The audible buzzer is activated in  
error condition, which includes write command (see table 6, and various other tables).

25 In view of Zuppich’s teaching, it would have been obvious to an ordinary skill in the art  
at the time the invention was made to employ well-known error-handling routine including an  
audible sound to the teachings of Pieters in order to let the users know the result of operation in  
user-friendly manner. Use of alerting means (i.e, blinking LED or buzzer sound) when the  
operations are not successfully performed is generally known in the art. Such feature can be  
particularly useful when the card interface and remote device interact in asynchronous manner in

that one device has to receive or acknowledged d of the other device. Accordingly, incorporating user-alerting or user-prompting means such as a buzzer so that users can fix the error condition would have been an obvious expedient, well within one ordinary skill in the art.

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### ***Response to Arguments***

6. Applicant's amended claims and remarks filed on November 10, 2004 have been fully considered, but it is the Examiner's view that the cited references (the Pieterse patent and Zuppich patent), taken alone or in combination, discloses the subject matter recited in  
10 presented claims.

First, Applicant argues "Looking at Pieterse et al. we see that it is the terminal device and not the host center, such as in the presently claimed invention, that originates the requires to update the value data in the IC card." (See remarks, 3<sup>rd</sup> paragraph thereafter).

It is the Examiner's view that Pieterse patent, throughout the document, discloses  
15 exchanging data between the terminal 13 and a remote host (col. 6, lines 28-54; col. 9, lines 22+). It appears that the users were given information first from the remote device, perhaps a prompt to enter authentication information (col. 6, lines 36+). Often in consummating a remote transaction, the users are prompted (or guided) to enter such information. As disclosed in figure 6, the information exchange appears to be initiated from the remote host – transaction unit (col.  
20 9, lines 7+). Suppose, *arguendo*, that Piterse discloses a terminal initiating the communication. It is the Examiner's view that such difference alone would not be patentably distinct over the Pieterse patent, unless the direction of the communication provides the patentable weight (i.e.,

why one ordinary skill in the art would be motivated to originate the communication from the host side instead of a terminal side).

Secondly, as shown in figures 2, 3, and 7, the device 1 is a portable terminal comprising a plurality of components including an adaptor. The authentication information is sent from and 5 received to the portable unit.

The amended claims and remarks describing these elements have been fully considered, but they are not persuasive, and therefore, the Examiner has made this Office Action final.

*Conclusion*

10 **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after 15 the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ahshik Kim whose telephone number is (571)272-2393. The examiner can normally be reached between the hours of 6:00AM to 3:00PM Monday thru Friday. The fax number directly to the Examiner is (571)273-2393.

5 If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (571)272-2398. The fax phone number for this Group is (703)872-9306.

10 Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

15 *All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.*

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

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Ahshik Kim  
Patent Examiner  
Art Unit 2876  
January 25, 2005

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